

## **REMARKS**

Claims 1-19 remain pending. Reconsideration is respectfully requested.

### **Section 121 Restriction:**

In response to the Examiner's restriction requirement under 35 U.S.C. § 121, Applicants elect Group I claims 1-6 and 18-19 **with TRAVERSE**.

The Examiner presented a restriction requirement requiring election of one of the following two inventions as defined by the Examiner:

- I. Claims 1-6 and 18-19, drawn to basic backup and archiving in a storage area network, classified in class 711, subclass 162.
- II. Claims 7-17, drawn to backup and archiving in a storage area network, including "freezing" a memory to create a snapshot of data and subsequently "thawing" the memory, classified in class 714, subclass 15.

The Examiner contends that Inventions I and II are "related as subcombinations disclosed as usable together in a single combination." However, Invention I and II are not *disclosed as subcombinations* usable together *in a single combination*. For example, embodiments of the method of claim 7 (Invention II) can be carried out on embodiments of the systems of claims 1 and 18 (Invention II). Similarly, the functionality performed by the program instructions of claim 13 (Invention II) can be carried out on embodiments of the systems of claims 1 and 18 (Invention II). Note that according to MPEP 806.05(d), subcombinations are two separate components of a combination. In other words, subcombinations usable together in a single combination are two non-overlapping components of a larger combination. For example, a claim to a seat bracket and a claim to a gear mechanism could be two separate subcombinations usable together in a bicycle combination. In the present application, claim 1 is directed to a storage area network and claim 7 is directed to a method. Claims 1 and 7 clearly do not have the relationship of

subcombinations usable together in a single combination under MPEP 806.05(d). Although claims 1 and 18 may vary in scope from claims 7 and 13, the Examiner has clearly mischaracterized Applicants' claims as being directed to separate subcombinations usable together in a single combination. Thus, the restriction requirement is improper.

A proper restriction requirement under M.P.E.P. 806.05(d) requires that the subcombinations "do not overlap in scope." There is clearly overlap in scope between the claims of group I and the claims of group II. Applicants are by no means asserting that the scope of the claims of group I is identical to the scope of the claims of group II. In fact, there are clearly differences in scope between the claims. However, some of the claims of group I do have some overlap in scope with some of the claims of group II. For example, For example, from even the most cursory glance, it is readily apparent that claim 1 (group I) recites a system that is configured to perform at least some of the functionality that is claimed in the method of claim 7 (group II). Since, claims of group I have some overlap in scope with claims of group II, restriction cannot be required under M.P.E.P. 806.05(d). Therefore, the Examiner's restriction requirement is improper.

Furthermore, according to M.P.E.P. 806.05(d), to state a proper restriction requirement for subcombinations usable together in a single combination, "[t]he Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." Moreover, M.P.E.P. 806.05(d) also states that "the burden is on the Examiner" to make this showing. The example given by the Examiner is that "subcombination I has separate utility such as use without the need to freeze the memory – i.e. uninterrupted use of the memory." However, the Examiner is merely pointing out differences in limitation between the claims. While the independent claims of group I do not specifically recite the freezing of backup data, neither do they preclude such freezing. If any different in limitation between independent claims signaled a separate utility, the entire separate utility requirement becomes meaningless. Moreover, all of the independent claims in both groups can cover embodiments as described in Applicants' disclosure that may freeze backup data. Thus, the Examiner

clearly has not shown a separate utility for one of the subcombinations other than in the disclosed combination. Moreover, the separate utility requirement is in regard to a utility “other than in the disclosed combination.” Instead of providing an example of a utility other than in the disclosed combination, the example has merely focused on a difference in limitations between the different claim groups.

Another shortcoming of the Examiner’s restriction requirement is in regard to the requirement of M.P.E.P. § 808 for the Examiner to also show “reasons why there would be a serious burden on the examiner if restriction is not required”. On page 3 of the Office Action, the Examiner states, “there would be a serious burden on the examiner if restriction is not required because the invention have acquired a separate status in the art in view of their different classification.” However, the Examiner’s reliance of a different classification to show a separate status in the art is misplaced because the purported classifications are clearly inaccurate and not separate for the two claim groups. The Examiner classified claims 1-6 and 18-19 (Invention I) in class 711, subclass 162 and claims 7-17 in class 714, subclass 15. However, these classifications could both be applied to all of the claims, and are thus not separate for the two groups.

According to the Manual of Classification, the definition of class 711, subclass 162 is for archiving and backup where a verbatim, redundant copy of the data is made. However, the claims of both inventions clearly recite making backup copies of data. Thus, class 711, subclass 162 applies to both inventions identified by the Examiner. The Definition for class 714, subclass 15 is for means or steps for recovery by restoring data in a data file, data for a process, to data at a previous point in time within a system for responding to a failure. However, this definition clearly applies to all the claims. Neither the claims of group I nor the claims of group II require “restoring data to a previous point in time with a system for responding to a failure”. Nor do they exclude such restoration of data. Thus, class 714, subclass 15 is not a truly separate classification for the claims of groups I and II.

As shown above, under an accurate classification, the Examiner has not established that separate classifications apply to the claim groups. Since the purported classifications are not very accurate and actually relate to all of the claims, the Examiner clearly cannot rely upon these flawed classifications to establish “a serious burden on the examiner if restriction is not required.” *See M.P.E.P. § 808.*

The Examiner also states, “there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search.” The Examiner does not provide any statement as to why the two groups of claims require a different field of search. According to M.P.E.P. § 808.02(d), a different field of search is shown, “[w]here it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s).” The Examiner has not provided any reasoning to show why a search for claims 1-6 and 18-19 (Invention I) would not be likely to result in finding art pertinent to claims 7-17 (Invention II). As shown above, both of the classifications identified by the Examiner apply to all of the claims. Therefore, a search under either of the Examiner’s classifications would be equally likely to find art pertinent to all of the claims. The Examiner clearly has not established that different fields of search would be required.

Since the Examiner’s has failed to establish a “serious burden on the examiner if restriction is not required”, Applicants’ assert that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement as required by M.P.E.P. § 808. Therefore, the Examiner’s restriction requirement must be withdrawn.

## **CONCLUSION**

Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5760-16500/RCK.

Also enclosed herewith are the following items:

- Return Receipt Postcard
- Petition for Extension of Time
- Notice of Change of Address

Respectfully submitted,

/Robert C. Kowert/

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